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Notification of Non-Compliant Appeal Brief
(37 CFR 41.37)

Application No.

09/942,520

Applicant(s)

ODOM, WAYNE

Examiner

Matthew Hoel

Art Unit

3714


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The Appeal Brief filed on 21 November 2007 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☐ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☒ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

This section should not contain arguments, please correct and submit the arguments in the appropriate section.


BRIDGET C. MONROE
PATENT APPEAL CENTER SPECIALIST



KARAWAY 01-01

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicants : Odom, et al.)
Serial No. : 09/942,520)
Filed : August 29, 2001)
For : Live and Electronic Wagering and)
Lottery Game)
Examiner : Hoel, Matthew D.)

Group Art Unit 3714

hereby certify that this correspondence is being deposited with the United States Postal Service as via Express Mail Post Office to Addressee, EB55946387745 with sufficient postage addressed to: Mail Stop Appeal Brief-Patent, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on

January 3, 2008
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Robert Ryan Morishita
Robert Ryan Morishita

APPELLANTS' REVISED BRIEF

Appellants, pursuant to 37 C.F.R. § 41.37 submit their brief in support of their appeal of the final rejection of all pending claims 7, 8, 12, and 14–28 in the above-identified application, a copy of which are provided in the Appendix.

I. Real Party in Interest

5 The present application has been assigned, in its entirety, to Karaway Gaming, a Nevada corporation having an address of 8797 East Broadway Blvd., Tucson, AZ 85710 (“Assignee”).

II. Related Interferences and Appeals

There are no related interferences or appeals concerning this application. Appellants previously filed appeals in an unrelated patent application, U.S. Patent Application Serial No. 10 09/977,138, which was directed to a similar invention. The appeal in U.S. Patent Application Serial No. 09/977,138 was decided in Appellants’ favor and the application was issued as U.S.

Patent No. 7,056,205. An appeal in U.S. Patent Application Serial No. 11/007,108, which is a continuation-in-part of the application under presently under appeal (U.S. Patent Application Serial No. 09/942,520), was withdrawn by the examiner and the application is undergoing further examination.

5 III. Status of the Claims

Claims 7, 8, 12, and 14–28 pending as of the Final Office Action dated August 10, 2007 stand finally rejected under 35 U.S.C. §103. Claims 1–6, 9–11, and 13 have been cancelled. The final rejection of claims 7, 8, 12, and 14–28 presented in an amendment filed May 17, 2007 is appealed.

10 IV. Status of Amendments

On February 18, 2003, Appellants submitted a response to the First Office Action (First) (dated November 12, 2002) cancelling claims 1–5 and presenting new claims 6–14. All claims were finally rejected in the Final Office Action (First) dated April 14, 2003. On July 14, 2003, Appellants filed a Response After Final Rejection amending claim 11, cancelling claim 13, re-
15 presenting claims 6–10 and claims 12–14, and presenting new claims 15–22 so that claims 6–12 and 14–22 remained pending. On July 29, 2003, Examiner issued an advisory action that the new claims 15–22 would not be entered as raising new issues. On November 19, 2003, Appellants filed a Request for Continued Examination requesting entry of the amendments in the Response After Final Rejection. The amendments were entered and all pending claims 6–12 and
20 14–22 were rejected in the First Office Action (Second) dated February 18, 2004. On April 19, 2004, Appellants cancelled claims 6 and 9–11, amended claims 7, 8, 12, 14, 15, and 19, and presented new claims 23–28 so that claims 7, 8, 12, and 14–28 remained pending in the

application. In response to a Notice of Non-Compliant Amendment, Appellants filed the same claims 7, 8, 12, and 14–28 on May 27, 2004. All claims were again finally rejected in the Final Office Action (Second) dated September 2, 2004.

Appellants filed a Notice of Appeal (First) on December 2, 2004 appealing the rejection
5 of all pending claims 7, 8, 12, and 14–28. On March 29, 2006, the examiner withdrew the Final Office Action (Second), thereby withdrawing the application from appeal and issued a new First Office Action (Third). In the First Office Action (Third), the examiner indicated that all claims would be allowable if certain claims were amended and a terminal disclaimer over U.S. Patent No. 7,056,205 was filed. In response to the First Office Action (Third), Appellants amended
10 claims 7, 8, 12, and 14–28, amended the specification and the drawings, and filed a Terminal Disclaimer on July 21, 2006. A Notice of Non-Compliant Amendment was mailed on August 8, 2006 and, in response, Appellants refiled the amended drawings transmitted on July 21, 2006. On April 10, 2007, the examiner issued a Second Office Action in which the examiner withdrew from his prior position and rejected claims 7, 8, 12, and 14–28. Appellants amended claims 15
15 and 23–25 and re-presented claims 7, 8, 12, 14, 16–22, and 26–28. On August 10, 2007, the examiner issued Final Office Action (Third) rejecting all claims pending 7, 8, 12, and 14–28.

V. Summary of Claimed Subject Matter

The present invention is directed to a method and electronic device for conducting a series of games using a single, finite inventory of game indicia. See p. 3, ll. 2–5. The pending
20 independent claims appealed herein are claims 15, 19, 23, 24, 25, and 26. The remaining claims 7, 8, 12, 14, 16–18, and 20–22 under appeal are dependent.

Independent claim 15 is directed to a series of games that includes randomly arranging an

inventory of game indicia. See *id.* at p. 3, ll. 9–10. For each game within the series of games, the player places a wager and game indicia are serially dealt from the arranged inventory. See *id.* at p. 3, l. 10. For each game within the series of games, a predetermined plurality of game indicia are randomly selected and displayed, and the game indicia are used to determine an outcome.

5 See *id.* at p. 3, ll. 10–12. As each game indicia is used, it is depleted, i.e. removed, from the inventory such that the randomly arranged inventory is serially traversed. See *id.* at p. 6, ll. 19–25. The outcome is compared to a schedule of winning outcomes and, if the outcome is a winning outcome, the player is rewarded. See *id.* at p. 6, l. 24–p. 7, l. 10. Prior to the play of each hand, the player may view the remaining constituency of the inventory, see *id.* at p. 7, ll. 6 –
10 12, and any game outcomes which, as a result of depletion, are removed from the universe of possible game outcomes. See *id.* at p. 7, ll. 11–14.

Independent claim 19 is directed to a device including a processor (reference number 101 in FIG. 4) that randomly arranges a finite inventory of game indicia. See *id.* at p. 3, ll. 16–18. The device also includes a display (reference number 100 in FIG. 4) and means for a player to
15 make a wager (reference numbers 22 and 24 in FIG. 1 and reference number 122 in FIG. 4) and prompt play of a game (reference number 26 in FIG. 1 and reference number 126 in FIG. 4). See *id.* at p. 5, ll. 6–9 and p. 11, ll. 7–12. In the optional embodiment illustrated, the wagering and prompting means correspond to “BET ONE” or “MAX BET” and “DEAL” buttons, respectively. See *id.* at p. 5, ll. 6–9 and p. 11, ll. 7–12. In response to the prompt, the processor randomly
20 selects and displays the appropriate quantity of game indicia from the inventory to define an outcome. See *id.* at p. 5, ll. 9–25 and p. 12, ll. 1–4. A player is rewarded for winning outcomes. See *id.* at p. 5, l. 22–p. 4, l. 2 and p. 12, ll. 4–12. The selected indicia for each game in the series

are depleted from the game indicia inventory such that certain outcomes may become unavailable. See *id.* at p. 7, ll. 11–14 and p. 12, ll. 17–19. The constituency of the remaining inventory is displayed (reference number 30 in FIG. 1 and reference number 118 in FIG. 4). See *id.* at p. 6, ll. 19–25 and p. 10, ll. 16–17. For the next subsequent game, the processor selects
5 from the depleted inventory. See *id.* at p. 6, ll. 25–27.

Independent claim 23 is substantially similar to independent claim 15. Independent claim 23 is directed to game method that includes randomly arranging the inventory of game indicia. See *id.* at p. 3, ll. 9–10. For each game within the series of games, the player places a wager and game indicia are serially dealt from the arranged inventory. See *id.* at p. 3, l. 10. For each game
10 within the series of games, a predetermined plurality of game indicia are randomly selected and displayed, and the game indicia are used to determine an outcome. See *id.* at p. 3, ll. 10–12. As each game indicia is used, it is depleted, i.e. removed, from the inventory. See *id.* at p. 6, ll. 19–25. The outcome is compared to a schedule of winning outcomes and, if the outcome is a winning outcome, the player is rewarded. See *id.* at p. 6, l. 24–p. 7, l. 10. Prior to the play of
15 each hand, the player may view the remaining constituency of the inventory, see *id.* at p. 7, ll. 6 – 12, and any game outcomes which, as a result of depletion, are removed from the universe of possible game outcomes. See *id.* at p. 7, ll. 11–14. For the next subsequent game, game indicia are selected from the depleted inventory. See *id.* at p. 6, ll. 25–27.

Independent claim 24 is directed to a game method that includes randomly arranging the
20 inventory of game indicia into a random serial order 1–X. See *id.* at p. 6, ll. 19–22. For each game within the series of games, the player places a wager and game indicia are serially dealt from the arranged inventory. See *id.* at p. 3, l. 10. For each game within the series of games, a

predetermined plurality of game indicia are randomly selected and displayed, and the game indicia are used to determine a winning or losing outcome. See *id.* at p. 3, ll. 10–12. As each game indicia is used, it is depleted, i.e. removed, from the inventory. See *id.* at p. 6, ll. 19–25. The outcome is compared to a schedule of winning outcomes and, if the outcome is a winning
5 outcome, the player is rewarded. See *id.* at p. 6, l. 24–p. 7, l. 10. Prior to the play of each hand, the player may view the remaining constituency of the inventory, see *id.* at p. 7, ll. 6 – 12, and any game outcomes which, as a result of depletion, are removed from the universe of possible game outcomes. See *id.* at p. 7, ll. 11–14. A player may elect to play the next subsequent game, game indicia using the depleted inventory, see *id.* at p. 6, ll. 25–27, or may elect to reconstitute
10 the inventory, i.e. reintroduce depleted game indicia and randomly rearrange the inventory, upon player command. See *id.* at p. 3, ll. 6–8 and p. 12, ll. 15–17.

Independent claim 25 is directed to a game method that includes randomly arranging the inventory of game indicia. See *id.* at p. 3, ll. 9–10. For each game within the series of games, the player places a wager and game indicia are serially dealt from the arranged inventory to a game
15 matrix. See *id.* at p. 9, ll. 8–15. For each game within the series of games, a predetermined plurality of game indicia are randomly selected and displayed, and the game indicia are used to determine a winning or losing outcome. See *id.* at p. 3, ll. 10–12. As each game indicia is used, it is depleted, i.e. removed, from the inventory. See *id.* at p. 6, ll. 19–25. The outcome is compared to a schedule of winning outcomes and, if the outcome is a winning outcome, the
20 player is rewarded. See *id.* at p. 6, l. 24–p. 7, l. 10. Prior to the play of each hand, the player may view the remaining constituency of the inventory, see *id.* at p. 7, ll. 6 – 12, and any game outcomes which, as a result of depletion, are removed from the universe of possible game

outcomes. See *id.* at p. 7, ll. 11–14. A player may elect to play the next subsequent game, game indicia using the depleted inventory, see *id.* at p. 6, ll. 25–27, or may elect to reconstitute the inventory, i.e. reintroduce depleted game indicia and randomly rearrange the inventory, upon player command. See *id.* at p. 3, ll. 6–8 and p. 12, ll. 15–17.

5 Independent claim 26 is directed to a device including a processor (reference number 101 in FIG. 4) that stores an arrangement of an inventory of game indicia. See *id.* at p. 3, ll. 16–18. The device also includes a video display (reference number 100 in FIG. 4) and means for a player to make a wager (reference numbers 22 and 24 in FIG. 1 and reference number 122 in FIG. 4) and prompt play of a game (reference number 26 in FIG. 1 and reference number 126 in FIG. 4).
10 See *id.* at p. 5, ll. 6–9 and p. 11, ll. 7–12. In the optional embodiment illustrated, the wagering and prompting means correspond to “BET ONE” or “MAX BET” and “DEAL” buttons, respectively. See *id.* at p. 5, ll. 6–9 and p. 11, ll. 7–12. In response to the prompt, the processor randomly selects and displays the appropriate quantity of game indicia from the inventory to define an outcome. See *id.* at p. 5, ll. 9–25 and p. 12, ll. 1–4. The processor compares the
15 outcome to a schedule of winning outcomes and a player is rewarded for winning outcomes. See *id.* at p. 5, l. 22–p. 4, l. 2 and p. 12, ll. 4–12. The selected indicia for each game in the series are depleted from the game indicia inventory such that certain outcomes may become unavailable. See *id.* at p. 7, ll. 11–14 and p. 12, ll. 17–19. The constituency of the remaining inventory is displayed (reference number 30 in FIG. 1 and reference number 118 in FIG. 4). See *id.* at p. 6, ll.
20 19–25 and p. 10, ll. 16–17. The device also includes means for prompting the processor to reconstitute the inventory to X. See *id.* at p. 12, ll. 15–19. According to the illustrated embodiment, the prompting means for reconstituting the inventory corresponds to a “SHUFFLE”

or “RE-SHUFFLE” button (reference number 28 in FIGS. 1 and 2 and reference number 120 in FIG. 4). See *id.* at p. 7, ll. 11–14 and p. 12, ll. 15–19.

VI. Grounds of Rejection to be Reviewed on Appeal

1. In the Final Office Action (Third) claims 7, 8, 12, and 14–28 were rejected as
5 obvious under 35 U.S.C. section 103 based on Kinoshita et al. (U.S. Patent 5,967,894) in view of
Richardson (U.S. Patent 5,042,809). In making the final rejection of claim 15, Examiner stated
that Kinoshita teaches the conduct of a game with a fully constituted inventory with “[t]he dealt
indicia ... depleted from play in subsequent hands.” See Final Office Action (Third), ¶ 4.
Examiner also states that “hand-to-hand” play is shown in Kinoshita since “[t]he player of
10 [Kinoshita] is able to insert plural medals” and “play continues until the player runs out of
medals or player presses ‘COLLECT/PAYOUT.’” See *id.* at ¶ 5. Examiner states that Kinoshita
“displays the possible winning hands remaining in the indicia set in the inventory as depleted and
displays any scheduled winning outcomes eliminated as a result of depletion of the inventory.”
See *id.* at ¶ 6. Examiner states that Richardson also “teaches displaying the number of indicia
15 remaining in the indicia set in the inventory as depleted and displays ... scheduled winning
outcomes eliminated as a result of depletion of the indicia inventory.” See *id.* Examiner
concludes that it would have been obvious to modify Kinoshita in view of Richardson,
particularly in view of the motivation provided in Morris et al., U.S. Patent No. 5,324,035,¹ to
“more precisely indicate which indicia remain in the pool of indicia rather than simply indicating
20 which kinds of winning combinations remain as is done in [Kinoshita].” See *id.* In the Final

1. Morris was referenced in the Final Office Action (Third) but was not cited as a basis for the rejection of the claims.

Office Action (Third), Examiner used a similar rationale for rejecting claims 19 and 23 based on Kinoshita in view of Richardson.² See *id.* at ¶¶ 7 & 8.

As to claims 24, 25, and 26, the Examiner rejected based on Kinoshita in view of Richardson using the same reasons given for claims 15 and 19, and additionally stated that

5 Richardson allows the player to “command reconstitution of the inventory ... prior to the play of the next game.” See *id.* at ¶¶ 9–11.

The Examiner rejected claims 7, 17, and 27 using Kinoshita in view of Richardson using a rationale similar to that used to reject claims 19 and 23. Examiner states that Richardson “does not disclose reconstituting to *X* indicia when a predetermined number of indicia remain in

10 inventory,” but states that this limitation is widely known in the art. For motivation, Examiner

references “Scarne’s Encyclopedia of Card Games” for teaching that “the dealer reconstitut[es] the deck at any time upon noticing player actions (Page 287) ... to prevent cheating.” See *id.* at ¶

12. Examiner also states that the combination of Kinoshita and Richardson or “applicant’s own invention” could be cited for the motivation to combine or modify Kinoshita and Richardson. See

15 *id.* Examiner concludes that it would have been “an obvious design choice” to modify

“[Richardson] or [Kinoshita] such that the deck is reconstituted when a predetermined number of indicia remain in the inventory.” See *id.*

Regarding claims 8, 14, 18, and 22, Examiner rejected based on Kinoshita in view of Richardson stating that Richardson teaches randomizing the inventory prior to dealing. See *id.* at

20 ¶ 13.

2. The Examiner also referenced, but did not cite, “Scarne’s Encyclopedia of Card Games” for the proposition that it is known to remove dealt indicia in a poker game.

As to claims 12 and 21, Examiner issued a rejection citing Kinoshita in view of Richardson finding that although Kinoshita fails to disclose multiple paylines, Richardson “suggests” this limitation because it “allows players to play multiple parallel games at the same time.” See *id.* at ¶ 14. Examiner states any differences between “multiple paylines” and the “multiple parallel games” shown in Richardson are not germane because “applicant has not stated that multiple paylines solves any stated problem or is for any particular purpose” and concludes that the modification to Kinoshita can be found in the fact that “applicant’s invention would perform equally well modified to incorporate multiple paylines.” See *id.*

As to claims 16, 20, and 28, Examiner rejected based on Kinoshita in view of Richardson using a similar rationale but further finding that Richardson “gives the player the option to make another wager to play a next game ... using the depleted inventory or to command reconstitution of the inventory to X number of indicia prior to the player of the next game.” See *id.* at ¶ 15.

2. In the alternate, Examiner states that claims 7, 8, 12, and 14–28 could be rejected under 35 U.S.C. section 103 based on Kinoshita in view of Richardson and Fuchs. As to claim 15, Examiner combines Kinoshita and Richardson as described in his primary rejection, but adds that Fuchs discloses “hand-to-hand display of remaining game indicia in a video poker game.” See *id.* at ¶ 19. As motivation to combine Fuchs and Kinoshita, Examiner references, but does not cite, “Scarne’s Encyclopedia of Card Games” and Moody, U.S. Patent No. 5,823,873 which disclose dealing multiple simultaneous hands.

Examiner utilizes the rationale given above for rejecting claims 19 and 23–26 based on Kinoshita and Richardson. See *id.* at ¶ 20–24.

Similarly, Examiner rejects claims 7, 17, and 27 (see *id.* at ¶ 25), claims 8, 14, 18, and 22

(see *id.* at ¶ 26), claims 12 and 21 (see *id.* at ¶ 27), and claims 16, 20, and 28 (see *id.* at ¶ 28) based on the combination of Kinoshita, Richardson, and Fuchs.

Appellants submit that the grounds for rejection as applied to the claims can be divided into three groups.

5 a. Group 1

Claims 15, 19, 21, and 23. Appellants submit that claim 19 is representative and the claims of the group stand or fall upon the resolution concerning the representative claim.

 b. Group 2

10 Claims 7, 12, 16, 17, 20, 25–28. Appellants submit that claim 26 is representative and the claims of the group stand or fall upon the resolution concerning the representative claim.

 c. Group 3

Claims 8, 14, 18, 22, and 24. Appellants submit that claim 24 is representative and the claims of the group stand or fall upon the resolution concerning the representative claim.

VII. Argument

15 A. Group 1 Claims

 1. Claim 19 is Not Rendered Obvious by Fuchs in View of Kinoshita in View of Richardson Because the References Fail to Show Depletion Across a Series of Games.

20 Claim 19 has been rejected as being obvious over Fuchs (U.S. Patent No. 5,630,753) (hereinafter “Fuchs”) in view of Richardson (U.S. Patent No. U.S. Patent 5,042,809) (hereinafter “Richardson”) further in view of Kinoshita et al. (U.S. Patent 5,967,894) (hereinafter “Kinoshita”). Claim 19 recites a method which includes selecting and displaying game indicia from an inventory of game indicia to define an outcome for a hand of play. As described in the

specification the game may be Blackjack, Baccarat, Poker or the like. If the outcome is a winning outcome according to the predetermined rules of the game, the player gets an award.

Claim 19 also recites depleting the game indicia available for subsequent game hands and display of the depleted inventory of game indicia (i.e., the inventory less the game indicia that have

previously been selected and displayed). The example set forth in the specification for the present application is instructive of this feature.

The display 100 also, according to the present invention, displays at 118 the inventory of symbols remaining for play. For example, where there are 63 symbols, after the initial shuffle, the inventory of display would display the following:

Symbols Remaining

Blue 7s	3
Red 7s	5
3Bars	7
2Bars	9
Bar	15
<u>Blanks</u>	<u>24</u>
Total	63

As hands or games are played, the inventory display 118 would be depleted based upon the depletion of the symbols from the serial inventory. For example, and with reference to FIG. 4, the inventory would be now shown to be the following (all 7s in FIG. 4 assumed to be Red 7s):

Symbols Remaining

Blue 7s	3
Red 7s	2
3Bars	7
2Bars	8
Bar	10
Blanks	24

Thus as games are played the player can assess the constituency of the remaining

inventory. This feature may alter the wagering decisions of the player, e.g. to increase or decrease the wagers. Specification, p. 10, ll. 3–29.

Claim 19 also recites displaying information to the player of any winning outcome eliminated by the depletion of the available data. For example, if deck depletion has eliminated
5 the possibility of the player obtaining three blue “7s” by, for example, depletion of all the blue “7s” from the inventory, the display would reflect this.

Claim 19 also recites conduct of a “next hand of play” from the depleted inventory. As set forth in the specification, each hand conducted includes the steps of the player making a wager, the random selection and display of game indicia, judging whether the outcome is a
10 winning or losing outcome, and depleting the inventory. Thus, for the next hand of play, the player would make another wager and play the hand using the depleted inventory. That is, in the example above, the player may play the next hand using an inventory depleted (by the play of the prior hand) from 63 game indicia to 53 game indicia.

Examiner relies upon Kinoshita and Richardson, possibly in combination with Fuchs, as
15 disclosing the features of claim 19. Appellants assert that (1) this interpretation of Kinoshita, Richardson, and Fuchs is contrary to the Board’s own interpretation of these references; (2) this combination does not disclose or suggest the features of claim 19 and that the application of this combination is a result of hindsight, (5) that Fuchs, in fact, teaches away from the claimed invention and (6) that the Examiner has not made the requisite showing of evidence for
20 obviousness.

Appellants respectfully submit that Kinoshita and Richardson do not disclose what Examiner asserts they do. Appellants direct the Board to the Appeal Decision in Appeal No.

2005-1071. The application at issue in that appeal was directed to a poker game with continuous depletion, which is directly analogous to a slot game with continuous depletion recited in the application at issue in the present appeal. In that appeal, the prior examiner had rejected claims with similar claim limitations based on Fuchs (U.S. Patent No. 5,630,753), alone or in
5 combination with Kinoshita and Richardson. In the appeal decision, the BPAI examined the disclosure of Kinoshita and stated:

We find no teaching in Kinoshita that the deck is not reconstituted and randomized (i.e. allowed to deplete) between hands of the poker game. Further, we find that Kinoshita does not teach displaying winning outcomes eliminated because of depletion. We find
10 that Kinoshita teaches that the outcomes are eliminated based upon the hold decisions made by the player *and not the depletion of the deck as claimed. Thus, we find that Kinoshita provides no teaching or suggestion of displaying winning outcomes eliminated because of depletion.* Appeal Decision, p. 9, ll. 17–24 (emphasis added).

With respect to Richardson, the BPAI examined claims reciting “the limitation of displaying
15 depletion of the data representing the cards in the deck over several hands and displaying outcomes eliminated due to depletion,” and specifically stated “we do not find that Richardson teaches modifying the video poker games of Fuchs or Kinoshita to include this limitation.” Appeal Decision, p. 10, ll. 13–18.

Despite Appellants directing Examiner to the prior interpretation by the Board in
20 response to the Final Office Action (Second), Examiner now asserts that Kinoshita and Richardson teach exactly what the Board found they do not teach. Examiner implies that the Board’s interpretation must have been mistaken because the changing display and the ability to

play using stored credits in Kinoshita necessarily implies depletion between games (referred to by Examiner as hand-to-hand depletion).

With respect to the changing display of possible winning hands, the Board found that the display does indeed change, but as a result of the player's choices, *not as a result of depletion*.

5 See Appeal Decision, p. 9, ll. 20–22. Kinoshita himself discloses that the display shows “already achieved prize-winning hands,” “a possible prize-winning hand ... and the corresponding odds,” and “impossible prize winning hands” based on the cards dealt and held. Kinoshita, col. 7, ll. 16–30. In other words, Examiner infers that Kinoshita shows a display because Kinoshita includes depletion between games. However, this ignores the Board's finding, as well as
10 Kinoshita's disclosure, that the display is to inform the player of the games that may be obtained based on the player's selected cards, rather than the unavailability of cards in a different game. In short, Examiner errs in assuming that the display implies depletion between games since there is an explicit teaching that states the purpose of the display is not to show the impact of a prior hand, but to illustrate the consequences of the player's choices in the present hand.

15 Additionally, Examiner infers from the use of stored game credits that the game of Kinoshita necessarily requires depletion between games. Again, Examiner is mistaken in his logic. Most casino gaming machines allow wagering using stored game credits so the player does not need to insert additional coins before each game is commenced. By Examiner's logic, it would be equally valid to argue that allowing the use of stored game credits necessarily implies
20 that inter-game depletion does not occur, since every machine on a casino floor that allows stored game credits does not deplete between games. However, such logic is equally flawed. Applicant merely points out that whether Kinoshita discloses the use of stored game credits is irrelevant in

interpreting Kinoshita. Put another way, without a teaching or suggestion in Kinoshita of inter-game depletion, it is improper for Examiner to infer such a teaching from something as elemental as gambling with stored game credits.

In sum, Appellants submit that Examiner's interpretation of Kinoshita conflicts directly
5 with the Board's interpretation of Kinoshita in the Appeal Decision. As such, Examiner's rejection of the claims of group 1 as represented by claim 19 should be reversed.

However, Appellants do not rely solely on the Board's prior decision for its position. A review of Kinoshita, Richardson, and Fuchs evidences that the Board's prior decision is supported by the disclosures of the references themselves. Specifically, there is nothing in
10 Kinoshita that discloses or suggests a continuously depleted deck. In fact, Kinoshita specifically refers to the use of the claimed teaching display with "a poker game." As may be appreciated, in a conventional video poker game, the deck is reconstituted and randomized before each game. Thus, contrary to Examiner's assertion, Kinoshita provides no teaching of depletion between hands and, to the extent that Kinoshita is directed to use with conventional video poker
15 machines, implies that the conventional step of reconstituting and randomizing between hands is to be conducted.

Examiner has not argued that Richardson discloses depletion between hands and, as such, Appellants presume that this is not a basis for the rejection. Similarly, Examiner has not argued that Fuchs discloses depletion between hands and, as such, Appellants presume that this is not a
20 basis for the rejection.³

3. Appellants note that Examiner asserts that Fuchs and Richardson disclose the related concept of a display of outcomes depleted from hand-to-hand, as addressed in the next section of

As the Board is well aware, Examiner bears the initial burden of factually supporting a prima facie case of obviousness. MPEP § 2142. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to be obvious in light of teachings of the references. MPEP §2142. Most importantly, the prior art reference (or references when combined) must teach or suggest **all** the claimed limitations. MPEP §2143. While the case of *KSR International Co. v. Teleflex Inc.* may have relaxed or removed the requirement of finding an explicit motivation or suggestion for a proposed combination, *KSR* did not relax or remove the requirement that each and every element be found in the prior art.

Here, Examiner has failed to show that Kinoshita discloses depletion of game indicia between games, each of which include a separate wager, deal, and outcome. Additionally, Examiner has not argued that depletion of game indicia between hands is shown in Richardson or Fuchs. Appellants respectfully request that the final rejection of claim 19 and the claims represented by claim 19 be reversed.

2. Kinoshita, Richardson, and Fuchs Do Not Render Claim 19 Obvious Because the References Fail to Show the Display of a Depleted Inventory.

Appellants further submit that the combination of Kinoshita and Richardson, alone or in combination with Fuchs, do not disclose or suggest the display of information to the player of elimination of any outcome *as a result of depletion* as set forth in claim 19. That is, claim 19

Appellant's brief, but does not assert that Fuchs and Richardson disclose hand-to-hand depletion. See Final Office Action (Third), ¶¶ 7 and 20.

specifically recites a “display prior to the play of the next hand data corresponding [to] the remaining inventory of indicia sets depleted of said displayed game indicia”

As a first matter, Examiner stated in the Final Office Action (Third) that this claim language only required the display of depleted outcomes and not the display of “remaining individual indicia.” See Final Office Action (Third), ¶ 7. Rather, Examiner focuses on the clause following the claim language quoted, and skips over the quoted claim language.

Appellants respectfully disagree that Examiner is permitted to disregard claim limitations in examination. That is, the claim language quoted above clearly recites the display of data corresponding to the remaining inventory and that this is distinguishable from the succeeding clause regarding a display of unavailable winning outcomes.

When the claims are properly interpreted, Kinoshita, Richardson, and Fuchs cannot be read to disclose the recited feature of a display of the “remaining inventory.” Specifically, in the prior Appeal Decision, the Board found that the claims at issue included “the limitation of displaying depletion of the data representing the cards in the deck over several hands and displaying outcomes eliminated due to depletion.” The second element is addressed more fully in the next section of the present brief, but as to the sufficiency of the cited references, the Board concluded that “we do not find that Richardson teaches modifying the video poker games of Fuchs or Kinoshita to includes this limitation.” Implicit in the logic of this statement is that neither Fuchs nor Kinoshita discloses the display of “depletion of data representing the cards in the deck over several hands,” and that the addition of Richardson’s disclosure does nothing to assist in modifying Fuchs or Kinoshita to suggest such an element. Based on the Board’s prior Appeal Decision, Appellants submit that Examiner’s rejection of the claims of Group 1 as

represented by claim 19 should be reversed.

Again, however, Appellants do not rely solely on the prior Appeal Decision. In reviewing the references, it is apparent that the Board's decision is well supported by the references themselves. Kinoshita does not disclose the display of deck constituency or even information
5 impacting a "next hand of play" as claimed. Rather, Kinoshita discloses a gaming machine with an instructional display of the hands that could be formed by the player's cards and the odds of obtaining certain potential hands based on the cards currently held by a player. Kinoshita, col. 5, ll. 39–42. For example, a player with two pair will have a certain probability of obtaining a full house if the unmatched card is discarded and replaced. Conversely, the player will have no
10 chance of obtaining, for example, a straight, if the two pair are held.

As noted above, Appellants have trouble responding to Examiner's argument because it obliterates the distinction between displaying possible outcomes and showing inventory constituency arising from actions in preceding hands. However, Appellants submit Kinoshita discloses showing "a prize-winning hand which may possibly be achieved by the replacement of
15 cards" in the present hand. Kinoshita, col. 5, ll. 39–41. Kinoshita does not disclose showing the remaining inventory of the indicia sets at all, let alone the remaining inventory resulting from depletion in a prior hand.

Richardson, discloses informing the player of the number of winning tickets that have been awarded as compared to the number of winning tickets in the ticket set, e.g. "10 of 12
20 MAJORS LEFT." See Richardson, FIG. 3. However, like Kinoshita, Richardson's display of the ratio of remaining winning outcomes for the present game is not the same as a display of the "remaining inventory of indicia sets" resulting from depletion as recited in the claims. As noted

above, Examiner does not address this point in the Final Office Action (Third), choosing instead to ignore the express language presented in Appellant's claim 19.

Fuchs discloses displaying the status of the stable of symbols during a hand of play. That is, Fuchs shows a player which "symbols are therefore left over ... so that the player can adjust his game accordingly." Fuchs, col. 9, ll. 64–67. As such, Fuchs, like Kinoshita, merely shows the constituency of the symbol stable based on the player's decisions in the immediate game and not the constituency of the symbol stable based on a prior game. Put another way, since Fuchs does not show or suggest depletion between games, it cannot show the inventory of the stable resulting from depletion in a prior hand, as claimed.

The purpose of the display highlights this distinction. In Fuchs, the purpose of the display is "so that the player can adjust his game accordingly," i.e. by deciding which symbols to hold for the upcoming spin. *Id.* Again, this is clearly directed to play *within* a game where those adjustments can be made. This is distinguishable from the present claims in which the display of the inventory is generated between games to show the impact of prior game play on the upcoming game.

In short, Kinoshita, Fuchs, and Richardson fail to show the status of a depleted deck of cards based on the conduct and play of a *preceding* hand as recited in the claims. Therefore, Appellants respectfully request reversal of representative claims 19 and the group represented thereby which includes this claim limitation.

3. The Cited Art Neither Shows Nor Suggests Displaying a Table of Outcomes Excluding Outcomes Eliminated by Depletion.

Claim 19 recites the display of outcomes excluding outcomes eliminated by intergame

deck depletion. Examiner asserts that Kinoshita, in combination with Richardson and/or Fuchs, discloses such a feature.

Let us not lose sight of what Fuchs and Kinoshita disclose. Fuchs displays to the player the replacement symbols available so that “the player can judge which game symbols he should
5 keep for a subsequent game, if he wants to keep any at all” Fuchs, col. 9, ll. 41–46. In other words, Fuchs shows the state of the symbol stable as a result of intragame deduction. Kinoshita displays “already achieved prize-winning hands,” “a possible prize-winning hand ... and the corresponding odds,” and “impossible prize winning hands” based on the cards dealt and held. Kinoshita, col. 7, ll. 16–30. In other words, Kinoshita shows the hands attainable as a result of
10 the cards *held by the player*. Neither of these references discloses the display of outcomes no longer possible as a result of depletion of an indicia inventory *in a prior hand*.

The Appeal Decision interpreting Kinoshita, Fuchs, and Richardson states as much. In the Appeal Decision, the Board found “that Kinoshita does not teach displaying winning outcomes eliminated because of depletion.” See Appeal Decision, p. 9, ll. 19–20. While the
15 Board did not specifically address whether Fuchs discloses the display of winning outcomes eliminated because of depletion, the Board found that the combination of Kinoshita and Fuchs failed to disclose such a limitation. See *id.* at p. 10, ll. 1–9. Since the Board found that Kinoshita does not disclose a display of winning outcomes eliminated because of depletion and that the combination of Kinoshita and Fuchs does not disclose such a display, logically, the
20 Board found that Fuchs does not disclose such a display either. As to Richardson, the Board found that “we do not find that Richardson teaches modifying the video poker games of Fuchs or Kinoshita to include [the limitation of displaying depletion of the data representing the cards in

the deck over several hands and displaying outcomes eliminated due to depletion].” See *id.* at p. 10, ll. 10–18. Since the Board found that none of Fuchs, Kinoshita, or Richardson discloses the display of winning outcomes eliminated as a result of hand-to-hand depletion, Appellants submit that Examiner’s rejection of the claims of group 1, as represented by claim 19, must be reversed
5 as all the claims of the group include such a limitation.

As above, Appellants do not rely solely on prior appeal decision by the Board. Rather, Appellants submit that, even if the references are reviewed anew, the Examiner’s rejection must be reversed. Examiner asserts that Kinoshita shows the exclusion of outcomes and this is true. Kinoshita shows altering the display of a list of outcomes based on the cards held in a player
10 hand. For example, if two pair are held, two pair (as an achieved outcome) and full house (as a possible outcome) are highlighted while other outcomes, such as straight flush, are dimmed. Kinoshita, col. 7, ll. 31–62.

However, this is not what is recited in the claims. The claims recite the exclusion of outcomes eliminated as a result of deck depletion that impacts the next hand of play before the
15 next hand is played. In fact, none of Kinoshita, Richardson, or Fuchs shows a table of outcomes excluding outcomes eliminated as a result of deck depletion from preceding hands. First, it is only logical that if none of these references shows depletion from preceding hands, none of these references can possibly show a table of outcomes that excludes outcomes not attainable as a result of deck depletion from preceding hands.

20 Rather, these references show elimination of possible outcomes caused by player choice, which is well known in the art. It is axiomatic that if a player holds certain cards, certain outcomes become unavailable on the draw. This is not due to deck depletion, but simply the play

of the game which uses only five cards. If a player holds a pair of 4s, he/she cannot get a Straight Flush, Royal Flush, four Aces, Straight or Flush simply because the holding of the pair of 4s makes these outcomes unavailable. They have not been eliminated by depletion. The outcomes have been eliminated by player choice.

5 Even accepting, for the sake of argument, Examiner's position that Kinoshita discloses inventory depletion between hands, and Appellants would assert that it does not, Kinoshita still only shows a display of outcomes based on the player's holding, *not* on the constituency of the inventory. Kinoshita constructs a display based on the holding of "X" cards, that the player has "A" outcome already obtained, could possibly obtain "B" outcome, and cannot obtain "C"

10 outcome. This does not tell the player whether, for example, the remaining inventory constituency could support Royal Flush or four Aces as recited in the claims. It would only tell the player that if he holds a pair of nines, he cannot obtain a Royal Flush or four Aces.

Examiner's argument that Kinoshita discloses or could be modified to disclose the claimed display requires that Kinoshita's table, *which is explicitly based on the cards held*, be

15 altered *so that it is no longer based on the cards held*. This, is contrary to the M.P.E.P. which directs that if a proposed modification of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are insufficient to render the claims *prima facie* obvious. M.P.E.P. section 2143.01.

Even accepting that Kinoshita can be altered to operate in a manner contrary to

20 Kinoshita's express teaching, one must further assume that the altered form of Kinoshita would be based on outcomes that can be formed based on remaining inventory constituency rather than some other form. This, too, is a leap since none of the references shows or suggests a table of

outcomes based on inventory constituency let alone a table of outcomes that excludes certain outcomes resulting from inventory depletion. Certainly, it is possible to make this leap in view of Appellant's teachings and Appellants would suggest that this is what Examiner has done in the rejection.⁴ However, Appellants respectfully suggest that this feature cannot be found in the
5 cited art.

In sum, Kinoshita fails to disclose or suggest a table of outcomes in which the table is based on deck constituency and excludes outcomes that are unavailable as a result of deck depletion across games. Moreover, this limitation is not disclosed or suggested by Fuchs or Richardson. In fact, Fuchs teaches away from this feature by providing:

10 "In order to ensure that an adequate number of game symbols is available at all times, provision can be made that after a certain number of games or after a certain number of game symbols have appeared, **the number of available game symbols can be added to in a random fashion or predetermined fashion...**" Col. 10, lines 1–6. Thus, Fuchs teaches that there must always be an adequate amount of game symbols to provide a chance for winning each winning
15 outcome. Appellant, on the other hand, lets depletion occur even to the point where certain outcomes become eliminated and it is the very fact of this elimination that is displayed in the claimed element. In other words, Fuchs never allows winning outcomes to be depleted and,

4. See, for example, Examiner's statement in rejecting claims 7, 17, and 27 based on Kinoshita and Richardson that motivation to combine can be found in the fact that "applicant's own invention, would perform equally well modified to incorporate this limitation." See Final Office Action (Third), ¶ 12. Such statements raise the question whether impermissible hindsight was used in rejecting other claims.

therefore, cannot disclose or suggest a claim limitation in which winning outcomes that are eliminated due to depletion of symbols are displayed.

It is respectfully submitted that, based upon the foregoing, any interpretation that Fuchs displays information as to which outcomes have been eliminated is incorrect and the Examiner's
5 rejections that may be based on such an interpretation should be reversed.

Finally, Richardson does not disclose a display of winning outcomes that have been eliminated as a result of depletion. Examiner points to the legend in FIG. 3 of Richardson that states "10 OF 12 MAJORS LEFT" as showing the claimed display of winning outcomes eliminated as a result of hand-to-hand depletion. However, the very legend identified by
10 Examiner, in fact, supports Appellant's position that Richardson does not show the claimed display. Richardson specifically teaches that a deal is played "only as long as at least one of the higher level winners [i.e. Major Wins] ... remains available to be won within the deal." See Richardson, col. 19, ll. 31–34. This means that, like Fuchs, Richardson is never conducted when one of the displayed outcomes is *eliminated*. Put another way, Richardson specifically teaches
15 that the game ends when a displayed outcome is eliminated; therefore, Richardson never performs the claimed step of displaying to a player the elimination of a winning outcome for the next hand, because Richardson never conducts a "next hand" after an outcome is eliminated.

In sum, Appellants respectfully submit that the cited art fails to show depletion across separate and independent hands played from a single finite inventory. Moreover, the cited
20 references fail to show the display of a depleted inventory or outcomes eliminated as a result of depletion. Appellant's argument is partly a logical argument, i.e. the prior interpretation of these references by the Board precludes such an interpretation. But Appellant's argument is also

grounded squarely in the references themselves which never disclose or suggest the claimed features. Rather, the cited references must be read with a strained interpretation with a series of unsupportable assumptions to find the recited features. Therefore, Appellants respectfully request reversal of Examiner's rejection of claim 19 and the group of claims represented thereby.

5 B. Group 2 Claims

1. Claim 26 is Allowable Over the Cited References Because Kinoshita, Richardson, and Fuchs Fail to Disclose or Suggest Reconstitution of a Depleted Inventory.

10 Representative claim 26 recites reconstitution of a depleted deck. Examiner has asserted that this claim limitation is shown by the combination of Fuchs, Kinoshita, and Richardson, with Examiner relying primarily on Richardson to stand for the proposition that deck reconstitution is known. It simply does not.

Richardson discloses a pull tab terminal. The characteristic of a pull tab terminal, as
15 distinguished from a slot machine, is that a predetermined quantity of winning tickets is guaranteed. That is, among the "X" tickets loaded into the machine, there will be, with absolute certainty, "Y" winning tickets. In a slot machine, by contrast, each pull has "Z" probability of being a winning outcome, but there is no guarantee that "X" pulls will produce "Y" winning outcomes.

20 In Richardson, a quantity of tickets is dealt from an inventory of tickets. In the example given, nine tickets are dealt. Richardson, col. 6, ll. 62–67. Players select tickets and selected tickets are revealed. *Id.* at col. 11, ll. 37–45. If a player wishes to refresh the display, a "New Deal" order causes nine new tickets to be dealt. *Id.* at col. 11, ll. 49–52. The previously revealed tickets are retired and unrevealed tickets are returned to the inventory. Once an insufficient

quantity of tickets exists to deal nine tickets to the display, the game is retired. *Id.* at col. 12, ll. 59–62. That is, *the ticket inventory is not reconstituted*. To the contrary, “[i]f a game is retired, the player can choose another game from the master game screen, or call the operator, or quit.” *Id.* at col. 12, ll. 62–64 (internal reference numbers omitted). Reconstitution is simply not an option, whether at the player’s demand or automatically upon the occurrence of a certain event.

Examiner has asserted that Richardson allows for “reconstituting a dead inventory.” This is simply not the case. Richardson does allow for discarding unexposed tickets and receiving a new deal of tickets. *Id.* at col. 11, ll. 47–49. This would be analogous to, for example, folding in a card game by discarding a hand and obtaining a new hand. The inventory of tickets, analogous to the deck of cards, however, cannot be reconstituted. *Id.* at col. 12, ll. 62–64. This is logical because the advantage of pull tab terminals is the predictability of the quantity of winners. If the player were allowed to reconstitute the inventory at will, the quantity of winners would be wholly unpredictable.

In sum, Richardson fails to disclose or suggest the reconstitution of an inventory. In fact, Richardson explicitly states that when an inventory is dead, the game is retired and cannot be played. Since Richardson neither discloses nor suggests the reconstitution of an inventory of cards upon demand or upon occurrence of an event, Appellants respectfully submit that Examiner’s rejection of representative claims 26, which contain such claim limitations, must be reversed.

C. Group 3 Claims

1. Claim 24 and the Group Represented Thereby Are Not Obvious in View of Fuchs, Richardson, and Kinoshita Because None of the Cited References Disclose or Suggest Randomly Ordering an Inventory and

Serially Dealing from the Ordered Inventory Across a Series of Games.

Claim 24 recites the feature of means for randomly arranging said playing card data into random serial order. As described in the specification, this feature randomizes the card data, e.g. cards, and arranges the data into a serial structure 1 through X, for example, representing a randomized deck of fifty-two cards.

The Examiner has rejected claim 24 as being obvious over Fuchs in view of Kinoshita. The Examiner's position is that it would be obvious for one of ordinary skill in the art that the symbols could be accessed randomly from the list data structure and then accessed serially. The Examiner has not cited any reference or evidence in support of this position. Neither Fuchs or Kinoshita disclose or suggest this feature.

Reversal of the rejection of this claim and the claims represented thereby is requested.

Conclusion

It is respectfully submitted that the cited references fail to render the pending claims obvious. Appellants respectfully submit that the cited art has been misinterpreted and certain assumptions regarding the disclosures made therein are simply not supported by the references themselves. In fact, the cited references would have a completely different meaning to one of ordinary skill in the art than the meaning ascribed to the references in the rejections. Simply put, the cited references fail to disclose or suggest depleting a finite inventory across separate and distinct games which each terminate with an outcome. Rather, the cited references only show depletion within a game prior to an outcome for that game. Additionally, the cited references fail to disclose or suggest displaying a depleted inventory from game to game and outcomes depleted from game to game. This interpretation has been adopted by the Board in deciding an appeal of

similar claims in another of Appellants' patent applications. Whether the Board chooses to follow its own prior interpretation of these references, or reviews these references anew, Appellants submit that the same conclusion must be reached — Examiner's interpretation is incorrect and the rejection of the claims must be reversed.

5 Similarly, the cited references can only be interpreted to disclose the display of outcomes unavailable due to player selection, not inventory depletion. Finally, the cited references fail to show constituting a finite inventory for serial traversal.


Appellants respectfully request that the rejections as to all claims be reversed.

Respectfully submitted,

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CLAIMS APPENDIX

1–6. (cancelled)

5 7. The method of claim 23 further comprising reconstituting said inventory to X number of individual indicia when a predetermined number of individual indicia remain in said inventory.

8. The method of claim 23 further comprising randomly selecting and displaying indicia by arranging said indicia into a random, serial order of 1 through X and selecting and displaying said
10 indicia in order from said arranged inventory.

9–11. (cancelled)

12. The device of claim 26 further comprising said processor configured to select and display
15 a matrix of indicia, said matrix including a plurality of pay lines each including an outcome, means for the player to wager on a plurality of said pay lines and said processor configured to compare the outcome for each wagered upon pay line to said schedule and to issue an award for each winning combination.

20 13. (cancelled)

14. The device of claim 12 further comprising said processor configured to arrange said inventory into a random serial order 1 through X, to serially select and display said indicia from

said arranged inventory.

15. A method for conducting a wagering game using an inventory of indicia, said inventory when fully constituted having X number of indicia arranged in sets of at least two indicia each,

5 the method comprising:

receiving a wager from a player to play each of a series of hands;

for each hand of play, randomly selecting and displaying a plurality of individual indicia from the inventory, the combination of indicia selected and displayed defining at least one hand outcome and depleting said selected indicia from play for subsequent hands;

10 comparing said hand outcome to a predetermined schedule of winning outcomes and if said hand outcome matches one of said schedule of winning outcomes, issuing an award to the player; and

prior to play of the next hand displaying the number of each indicia remaining in each indicia set in the inventory as depleted and displaying any scheduled winning outcomes

15 eliminated as a result of depletion of said indicia inventory.

16. The method of claim 15 further comprising the player (i) making another wager to play a hand using the depleted inventory or (ii) commanding reconstitution of the inventory to X number of indicia prior to the play of the next hand.

20

17. The method of claim 15 further comprising reconstitution of the inventory to X number of indicia when a predetermined number of indicia remain in said inventory.

18. The method of claim 15 further comprising randomly selecting and displaying indicia by arranging said indicia into a random, serial order of 1 through X and selecting and displaying said indicia in order from said arranged inventory.

5 19. An electronic device for conducting a game for a player, said game utilizing an inventory of X number of game indicia arranged in sets of at least two indicia each when said inventory is fully constituted, the device comprising:

a computer processor storing data corresponding to said inventory;

a video display;

10 means for a player to make a wager and prompt play of the game;

said processor, in response to said prompt, configured to randomly select and display at said display a combination of individual indicia selected from said inventory of indicia, said selected and displayed indicia combination defining at least one outcome, said processor configured to remove said selected indicia from selection for future hands;

15 said processor configured to compare each outcome to a predetermined schedule of winning outcomes stored in a data structure, to issue an award for each selected and displayed winning outcome, to control the display to display prior to the play of the next hand data corresponding the remaining inventory of indicia sets depleted of said displayed game indicia including the display of data corresponding to the depletion of indicia from said inventory such

20 that one or more scheduled winning outcomes are unavailable due to depletion and said processor configured to, for the next hand of play, select indicia from the depleted inventory.

20. The device of claim 19 further comprising input apparatus for the player to input a re-shuffle signal to said processor to prompt the processor to reconstitute said indicia inventory to X number of game indicia.

5 21. The device of claim 19 further comprising said processor configured to select and display a matrix of indicia, said matrix including a plurality of pay lines each including an outcome, means for the player to wager on a plurality of said pay lines and said processor configured to compare the outcome for each wagered upon pay line to said schedule and to issue an award for each winning combination.

10

22. The device of claim 19 further comprising said processor configured to arrange said inventory into a random serial order 1 through X, to serially select and display said indicia serially from said arranged inventory.

15 23. A method for conducting a wagering game using an inventory of indicia, said inventory when fully constituted having X number of individual indicia, the method comprising:
receiving a wager from a player to play each of a series of hands;
for each hand of play, randomly selecting and displaying a plurality of individual indicia from the inventory, the combination of individual indicia selected and displayed defining a
20 winning or losing outcome for the hand and depleting said displayed individual indicia from the inventory available for play of the next hand;
for a winning outcome, issuing an award to the player;

prior to the commencement of the next hand of play displaying to the player information regarding any winning outcomes eliminated by said depletion of indicia; and

the player making another wager to play a hand using the depleted inventory.

5 24. A method for conducting a wagering game using an inventory of indicia, said inventory when fully constituted having X number of indicia arranged in indicia sets of at least two indicia each, the method comprising:

receiving a wager from a player to play the game;

arranging the inventory into a random serial order 1 through X;

10 serially selecting and displaying a plurality of individual indicia from the inventory, the combination of selected and displayed individual indicia defining a winning or losing outcome and depleting said displayed indicia from the inventory available for play of subsequent hands;

for a winning outcome, issuing an award to the player;

prior to play of the next hand displaying to the player any winning outcomes eliminated
15 by depletion of the indicia and the number of each indicia remaining in each indicia set in the inventory as depleted of the prior selected and displayed inventory; and

the player (i) making another wager to play the game using the depleted inventory or (ii) commanding reconstitution of the inventory to X number of indicia prior to the play of the next game.

20

25. A method for conducting a wagering game using an inventory of indicia sets, said inventory when fully constituted having X number of indicia, the method comprising:

receiving a wager from a player to play the game;

for each hand of play, randomly selecting and displaying a plurality of indicia from the inventory into the coordinates of a game matrix, the combinations of indicia in the game matrix defining a plurality of winning or losing outcomes and depleting said displayed indicia from the

5 inventory available for play of subsequent hands;

for each winning outcome, issuing an award to the player;

prior to play of a subsequent hand, displaying the number of each indicia remaining in the sets in the inventory as depleted of the prior selected and displayed inventory and any winning outcomes eliminated as a result of depletion; and

10 the player opting to (i) make another wager to play a next game using the depleted inventory or (ii) commanding reconstitution of the inventory to X number of indicia prior to the play of the next game.

26. An electronic device for conducting a game for a player, said game utilizing an inventory
15 of X number of game indicia when said inventory is fully constituted, the device comprising:

a computer processor storing an arrangement of said inventory;

a video display;

means for a player to make a wager and prompt play of the game;

said processor, in response to prompting, configured to randomly select and display at
20 said display indicia selected from said inventory of indicia, a plurality of selected and displayed indicia defining an outcome and to preclude said selected indicia from selection from said inventory;

said processor configured to compare said outcome to a schedule of winning outcomes stored in a data structure, to issue an award for a winning combination and to control the display to display prior to play of the next hand any scheduled winning outcomes eliminated by depletion of said indicia; and

5 means to prompt the processor to reconstitute said indicia inventory to X number of game indicia.

27. The device of claim 26 further comprising said prompting means comprising said processor configured to reconstitute the inventory to X number of game indicia when a
10 predetermined number of indicia remain in said inventory.

28. The device of claim 26 further comprising said prompting means comprising means for a player to input a prompt to the processor to reconstitute the inventory to X number of game indicia.

EVIDENCE APPENDIX

NONE

RELATED PROCEEDINGS APPENDIX

Exhibit A - Appeal Decision in Appeal No. 2005-1071

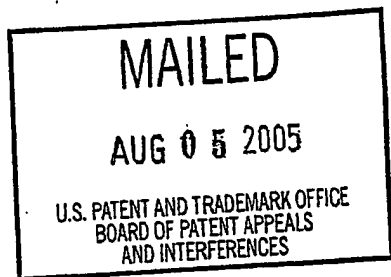


The opinion in support of the decision being entered today
was **not** written for publication and
is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WAYNE ODOM and KAROLYN GEE



Appeal No. 2005-1071
Application No. 09/977,138

HEARD July 13, 2005

Before RUGGIERO, SAADAT, and NAPPI, Administrative Patent Judges.

NAPPI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 2 through 48 which constitute all the claims remaining in the application. For the reasons stated *infra* we will not sustain the examiner's rejection of claims 2 through 48.

THE INVENTION

The invention relates to a video poker game where data representing a deck of cards are randomized (shuffled) and used to play a hand of cards, the

cards in the deck remaining for play are displayed to a player (i.e. the depleted deck). See page 4 of appellants' specification, field 34 in appellants' figures 1 and 2. The player may play several hands of poker without re-constituting (re-inserting the played cards and re-shuffling) the deck. A pay table, an indication of the payout for various hands, is also displayed to the user, the pay table is updated to remove any hands which are no longer achievable due to depletion of the cards from the deck. See page 12 of appellants' specification.

Claim 11 is representative of the invention and is reproduced below:

11. An electronic device for playing a [sic] hands of a card game according to the rules thereof utilizing data representing a deck of N playing cards:
 - a first data structure storing data representing each playing card of said deck;
 - a processor, said processor configured to include means for randomly arranging said playing card data into a random, serial order;
 - a video display;
 - means for a player to make a wager and prompt play of the game;
 - said processor, in response to prompting, configured to select and display at said display data from said first data structure representing a predetermined number of cards selected in order from said arranged data inventory to define an initial holding;
 - a control device for completing said initial holding according to the rules thereof by at least one of (1) replacing at least one card of the initial holding or (2) selecting additional cards, said processor configured to select and display at said display from said first data structure data representing each replacement or additional cards selected in order from said arranged data to define a final outcome for the hand of play;
 - said processor configured to display at said display data corresponding to the remaining constituency of said deck data depleted of said displayed card data;

said processor further configured to display data that said depletion has eliminated a final outcome; and
said processor configured to determine if said final outcome is a winning or losing outcome and to issue an award for winning a combination.

THE REFERENCES

The references relied upon by the examiner are:

Richardson	5,042,809	Aug. 27, 1991
Fuchs	5,630,753	May 20, 1997
Kinoshita et al. (Kinoshita et al.)	5,967,894	Oct. 19, 1999

THE REJECTIONS AT ISSUE

Claims 2 through 4, 6 through 14, 16 through 20, 22 through 30, 32 through 38 and 40 through 48 stand rejected under 35 U.S.C. § 103 as being obvious over Fuchs in view of Kinoshita. Claims 5, 15, 21, 31, and 39 stand rejected under 35 U.S.C. § 103 as being obvious over Fuchs in view of Kinoshita and Richardson. The Final Rejection, dated October 6, 2003, also provisionally rejects claims 1-36 under the judicially created doctrine of obviousness type double patenting in view of the claims of application 10/121,884, however this rejection was not addressed in the examiner's answer, accordingly we dismiss the appeal of this rejection.

Throughout the opinion we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellants and the examiner, for the reasons stated *infra* we will not sustain the examiner's rejection of claims 2 through 48 under 35 U.S.C. § 103.

Appellants argue, on page 9 of the brief:

Fuchs does show intra hand depletion, however it does not disclose (1) depletion which carries over to subsequent hands of play as set forth in claim 37 nor does it show (2) display of the elimination of outcomes which may occur as a result of depletion.

On pages 10-11 of the brief, appellants argue:

Those skilled in the art would interpret Fuchs to provide (1) a game having an initial deal, (2) with the next game being played by holding/discarding the symbols of the initial deal, i.e., first game to produce an outcome (game 1 outcome) and (3) a next game where the player can hold/discard symbols from the previous outcome (game 1 outcome) to, in essence "build" one or a series of outcomes. That is, Fuchs does not carry over deck depletion to the next hand as set forth in claim 37, but merely provides for deck depletion during the play of one hand, which may encompass a series of outcomes. Fuchs does not disclose or carry over deck depletion to the next hand.

On page 11 of the brief, appellants assert:

Fuchs does not disclose or suggest the display of information to the player of elimination of any outcome as a result of depletion as set forth in claim 37. Fuchs discloses the display of possible outcomes based upon the player's hold decisions.

Further, on page 12 appellants state:

[D]isplaying the probabilities of obtaining a winning outcome [as disclosed in Fuchs] is vastly different from displaying the outcomes which have been eliminated as a result of depletion.... Any eliminated outcomes would only become known based upon (1) the cards dealt to the player and (2) the player's hold decisions.

In response, the examiner asserts, on page 11 of the answer, that Fuchs does disclose that depletion carries over from hand to hand citing, column 9 lines 52-67 of Fuchs, with emphasis on lines 61-63 which states "from game to game the symbols offered to each player would be deducted from the originally existing symbols." Further, the examiner states on page 12 of the answer, "The additional teachings of Kinoshita et al. were used to provide support for the display of eliminated outcomes." On page 13 of the answer, the examiner asserts that Kinoshita teaches a pay table wherein outcomes that have been eliminated are displayed and that in combination with Fuchs teaches that displaying outcomes that have been eliminated because of depletion. The examiner states "[i]n gaming it is the combination of data that counts, thus motivation exists to apply Kinoshita et al. to Fuchs in order to provide clarity in the display to aid the player."

We disagree with the examiner's findings regarding Fuchs. In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and arguments." *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Initially we note that claims 37 and 42 are the only claims that contain claim limitations which directly claim depletion of the deck from playing several

hands. Claim 37 contains the limitation "(g) to play subsequent hands repeating steps (b) –(f)" where steps (b)-(f) deplete the deck and step (a) is a step of storing a representation of each card in the deck (analogous to reconstituting and re-shuffling the deck). Claim 42 contains the limitation "(d) displaying a tally corresponding to the constituency of the deck data of said data structure depleted of said cards displayed in the play of preceding hands." We find that the term "hand" has its customary meaning in card games, that is, the discrete part of the game in which wagers are paid, which is consistent with appellants' use of the term in the specification. See page 2 lines 8-9 of appellants' specification. Thus, we find that the scope of independent claims 37 and 42 explicitly includes displaying depletion of the data representing the cards in the deck over several hands and displaying outcomes eliminated due to depletion.

Further, we find that independent claims 11, 17, 27, 44 and 47 are implicitly directed to displaying depletion of the data representing the cards in the deck over several hands and displaying outcomes eliminated due to depletion. Independent claims 11, 17, 27, 44 and 47 all contain limitations directed to displaying an indication of outcomes eliminated by depletion (claim 44 and 47 use the term exclusion, which we consider to be similar to depletion). We find that outcomes can not be eliminated by depletion unless the deck is depleted by several hands of play. Claim 11 identifies that the displayed data corresponds to "the remaining constituency of said deck data depleted of said

displayed card data.” Independent claims 17, 27, 44 and 47 contain similar limitations. Thus, the term depletion is the term that describes the process whereby cards become unavailable from the deck. If only one hand of cards is dealt from a fully constituted deck, we find no scenario where any winning outcome can be eliminated based upon the cards which are dealt (depleted from the deck). It is only when more than one hand is dealt from the deck that winning outcomes can be eliminated because of depletion. Thus, we find that these claims are limited to inter-hand depletion.

In summary, we find that the scope of all the independent claims, claims 11, 17, 27, 37, 42 and 44¹, includes displaying depletion of the data representing the cards in the deck over several hands and displaying outcomes eliminated due to depletion.

We acknowledge that the sections of Fuchs the examiner relies upon appear to disclose depletion of the group of symbols (cards in a deck) over several games. However, in our review of Fuchs we find that Fuchs’ uses the term game to mean an additional play of cards, i.e. Fuchs uses the term game to both describe the inter hand deal of cards and the intra hand deal of cards. See for example Fuchs states, in column 6, lines 20-25:

¹ We note the following ambiguities in the claims. Claims 17, 37, 42 and 44 are all method claims and include the step of “a player making wages” (i.e. a person); this step is ambiguous as it is impossible for a person to be a method step. Further, as agreed upon by counsel at oral hearing, claim 44 more properly reads “displaying data corresponding to a *hand* outcome eliminated by exclusion.

In the present case, since it is a type of poker game that is being played, the computer unit 5 has suggested that two game symbols 3', namely the two aces, should be stored and at the same time it displays the possible ways of winning the next game by obtaining five, four or three aces and the possible ways of winning are assigned various values in the display fields

Thus, we find it clear that Fuchs is using the term game to include the deal of cards within a hand of poker. Further, we find no examples in Fuchs that discuss the deck of cards is not being reconstituted and randomized between segments of play where wagers are distributed (i.e. hands of poker). Rather, we find that Fuchs is ambiguous as to whether the deck of cards is reconstituted and randomized, or is allowed to be depleted, between hands.

We find that Kinoshita teaches a video poker game, where based upon the player's selection of which cards to hold (appellants' claimed step of selecting and Fuchs step of storing) and the pay table of possible outcomes is adjusted based upon what is achievable. See figures 8(a)-8(c) and description in column 7, lines 25-62. We find no teaching in Kinoshita that the deck is not reconstituted and randomized (i.e. allowed to deplete) between hands of the poker game. Further, we find that Kinoshita does not teach displaying winning outcomes eliminated because of depletion. We find that Kinoshita teaches that the outcomes are eliminated based upon the hold decisions made by the player and not the depletion of the deck as claimed. Thus, we find that Kinoshita provides no teaching or suggestion of displaying winning outcomes eliminated because of depletion.

As we consider the scope of independent claims to include the limitations of: displaying depletion of the data representing the cards in the deck over several hands and displaying outcomes eliminated due to depletion; and we find that the reference's teaching directed to this limitation is ambiguous, we find that the examiner has not carried the burden of proving that the claims are unpatentable. Accordingly, we will not sustain the examiner's rejection of Claims 2 through 4, 6 through 14, 16 through 20, 22 through 30, 32 through 38 and 40 through 48 under 35 U.S.C. § 103 as being obvious over Fuchs in view of Kinoshita.

We next consider the examiner's rejection of claims 5, 15, 21, 31, and 39 under 35 U.S.C. § 103 as being obvious over Fuchs in view of Kinoshita and Richardson. Claims 5, 15, 21 and 31 ultimately depend upon claims 37, 11, 17 and 27, respectively, and as such the scope of these claims includes the limitation of displaying depletion of the data representing the cards in the deck over several hands and displaying outcomes eliminated due to depletion. Thus, we do not find that Richardson teaches modifying the video poker games of Fuchs or Kinoshita to include this limitation. Accordingly, we will not sustain the examiner's rejection of claims 5, 15, 21 and 31.

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In summary we will not sustain the examiner's rejection of claims 2 through 48 under 35 U.S.C. § 103. The appellants and the examiner should take appropriate action to clarify the ambiguities noted in claims 17, 37, 42 and 44.

REVERSED

Joseph F. Ruggiero
JOSEPH F. RUGGIERO
Administrative Patent Judge

MAHSHID D. SAADAT
MAHSHID D. SAADAT
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES


ROBERT E. NAPPI
Administrative Patent Judge

REN/vsh

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Application No. 09/977,138

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